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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/757,353	01/09/2001	Tymarshall E. Royston	40693	8152

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EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 10/27/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/757,353

Applicant(s)

ROYSTON, TYMARSHALL E.

Examiner

James W Myhre

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-13 and 18-23 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 8-13 and 18-23 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. The amendment filed on July 30, 2004 is sufficient to overcome the prior rejections based on the Fajkowski (5,905,246), Thompson (5,865,470), and Christensen (6,035,280) references. The amendment canceled Claim 1-7 and 14-17 and added new Claims 18-23. Thus, the currently pending claims considered below are Claims 8-13 and 18-23.

Specification

2. The amendment filed on July 30, 2004 corrected the informality on page 8 of the specification objected to in paragraph 1 of the Office Action of June 16, 2004. Thus, the Examiner hereby withdraws that objection.

Claim Rejections - 35 USC § 112

3. The amendment filed on July 30, 2004 cancelled Claim 14, rendering moot the 35 U.S.C. 112, second paragraph, rejection in paragraph 3 of the Office Action of June 16, 2004. Thus, the Examiner hereby withdraws that rejection.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 8-13, 18, and 20 are rejected under 35 U.S.C. 102(b) as being anticipated by Nichtberger et al (4,882,675).

Claim 8: Nichtberger discloses a system for processing coupons, comprising:

- a. a database of coupon card accounts, each account including a personal identification number associated with the consumer, a plurality of selected coupons with redemption criteria, and a consumer-selected vendor name (Figures 10 and 11);
- b. a portable coupon card containing the consumer's personal identification number (col 5, lines 7-9 and 48-51);
- c. a vendor computer (POS) which receives the coupon card account data (i.e. selected coupon data with redemption criteria) for the consumer identified by the personal identification number on a card presented at the vendor location (col 5, lines 10-15 and col 11, lines 46-50);
- d. a database of the vendor's products with price and inventory data (col 17, lines 45-48);
- e. means for reading the personal identification number from a presented card (col 5, lines 10-15 and col 17, lines 45-48); and
- f. means for modifying the purchase price of a selected product based on a selected coupon within the received coupon card account data (col 17, lines 49-61).

Claim 9: Nichtberger discloses a system for processing coupons as in Claim 8 above, and further discloses transmitting the redeemed coupon data to the host computer (i.e. central processing unit) (col 5, lines 26-31).

Claim 10: Nichtberger discloses a system for processing coupons as in Claim 8 above, and further discloses establishing a new coupon card account based on registration data including demographical data about the applicant received through the network and assigning a new personal identification number to the new record (col 5, line 57 – col 6, line 23).

Claim 11: Nichtberger discloses a system for processing coupons as in Claim 8 above, and further discloses reducing the price of a purchased product based on the value of a respective selected coupon if the coupon is valid (e.g. prior to expiration date and redemption limit not reached) (col 17, lines 49-61).

Claim 12: Nichtberger discloses a system for processing coupons as in Claim 11 above, and further discloses adjusting the number of redemption left each time a coupon is redeemed (Figure 18).

Claim 13: Nichtberger discloses a system for processing coupons as in Claim 8 above, and further discloses using a bard code reader to read the personal identification number from the coupon card (col 5, lines 46-56).

Claim 18: Nichtberger discloses a system for processing coupons as in Claim 8 above, and further discloses forwarding the selected coupon data to the vendor (POS) upon completion of the coupon selection by the consumer (col 17, lines 20-41).

Claim 20 Nichtberger discloses a system for processing coupons as in Claim 8 above, and further discloses selecting the coupons from an online library (database) of available coupons (col 27, lines 42-61).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 19 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nichtberger et al (4,882,675).

Claim 19: Nichtberger discloses a system for processing coupons as in Claim 10 above, and further discloses receiving registration data from the consumer via a vendor. It is further disclosed that the coupon card issuer will return a confirmation to the central processor once the card has been mailed (col 6, lines 5-23). However, it is not explicitly disclosed that upon completion of the registration process, notification is sent back to the vendor. However, it would have been obvious to one having ordinary skill in the art

at the time the invention was made to notify the vendor upon successful registration of a new consumer. One would have been motivated to notify the vendor in order for the vendor to complete the current transaction and to notify the consumer, who is submitting the registration request from the vendor location, of the new personal identification number (temporary and/or permanent).

Claim 21: Nichtberger discloses a system for processing coupons as in Claim 8 above, but does not explicitly disclose buying the card from an ATM machine (i.e. vending machine). Official Notice is taken that it is old and well known within society to purchase discount cards, such as the "One-Day Pass" for riding the Washington, DC, metro system; and to purchase these cards from vending machines. The Examiner notes that the claimed ATM machine is one common type of vending machine found throughout society. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to distribute the portable coupon cards in Nichtberger through ATM or other vending machines and to charge the consumer for the card. One would have been motivated to distribute the cards in this manner in order to increase the availability and exposure of the coupon card system to many consumers and to charge for the card in order to help dissuade consumers from obtaining a plurality of portable coupon cards and then not utilizing the coupons thereon, i.e. consumers would desire to "get their money" back" by purchasing the products on the coupons at the discounted price.

8. Claims 22 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nichtberger et al (4,882,675) in view of Thompson (5,865,470).

Claims 22 and 23: Nichtberger discloses a system for processing coupons as in Claim 8 above, and further discloses the portable coupon card having a personal identification code on one side and a magnetic strip for storing the personal identification number on the other (col 5, lines 7-9). While Nichtberger does not explicitly disclose what additional information is printed on the card, Thompson discloses a similar system for processing coupons which includes a plurality of product identifiers to include company, product name, coupon parameters, etc. (Figure 24; col 3, lines 18-31; and col 8, lines 1-2) printed on the opposite side of the card from the magnetic strip. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to print such information (or any other desired information) on the card. One would have been motivated to print the coupon data on the card in order to alert the consumer while shopping as to which products have discounts available, as Nichtberger does by printing out a list of the selected coupons for the consumer to carry around while shopping.

Response to Arguments

9. Applicant's arguments with respect to claim 8 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Day et al (5,857,175) discloses a system for offering targeted discounts to consumers using a portable coupon card on which is stored a personal identification number. The system allows the consumer to select one or more desired coupons, send the selected coupons to the POS terminal, and then redeems the coupons based on the personal identification number and the products being purchased.

b. Kitsukawa et al (6,282,713) discloses a system for providing on-demand electronic advertising and coupons over a network and sending the selected advertisement or coupon directly to the selected merchant.

c. Kernahan et al (US2002/0128903) discloses a system for encrypting coupons selected by a consumer via his online home computer, selecting a merchant, and delivering the selected coupons directly to the selected merchant.

d. Thakur et al (US2002/0194069) discloses a system for providing discounts to consumers using a magnetic strip card containing information identifying the consumer.

e. Jaalinoja et al(US2003/0014315) discloses a system for obtaining discount services through the use of a portable token identifying the user.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 3:30 p.m.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (703) 746-5544.

Application/Control Number: 09/757,353
Art Unit: 3622

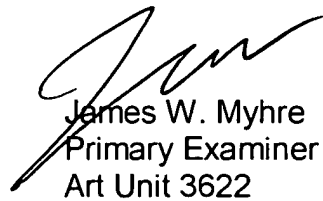
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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM

October 19, 2004



James W. Myhre
Primary Examiner
Art Unit 3622